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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/559,478	04/27/2000	Richard A. Simon	81020F-P	1867

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PATENT LEGAL STAFF
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EXAMINER

SCHLAIFER, JONATHAN D

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 09/17/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/559,478

Applicant(s)

SIMON, RICHARD A.

Examiner

Jonathan D. Schlaifer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/27/2000, IDS on 8/14/2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other:

DETAILED ACTION

1. This action is responsive to application 09/559,478 filed on 4/27/2000, with prior art filed on 8/14/2000.
2. Claims 1-26 are pending in the case. Claims 1, 16, and 22-25 are independent claims.

Priority

3. This application claims no special priority.

Specification

4. The disclosure is objected to because of the following informalities: In line 5 of page 1 of the disclosure, the word "digital" should be followed by the word "images" or the like. Appropriate correction is required.

Claim Objections

5. Claim 17 objected to because of the following informalities: On line 1 of the claim, "where in" should be "wherein". Appropriate correction is required.
6. Claim 18 objected to because of the following informalities: On line 1 of the claim, "17" should be followed by ", wherein". Appropriate correction is required.
7. Claim 20 objected to because of the following informalities: On line 2 of the claim, "is" should be followed by "the". Appropriate correction is required.
8. Claim 21 objected to because of the following informalities: On line 1 of the claim, "17" should be followed by ", wherein". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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9. Claim 26 recites the limitation "computer software product" in line 1. There is insufficient antecedent basis for this limitation in the claim. For examination purposes, the claim will be treated as if it read, "A computer software product which implements the method of claim 25 further causing a computer that runs it to perform the additional step of permitting a user to request another page layout."

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 1-15 and 23-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Independent claims 1 and 23-25 all lack a technological basis for carrying out the designed purpose of the invention, and claims 2-14 merely modify claim 1. This rejection could be overcome by modifying the claims to better reflect the presence of the computer system that is incorporated into the specification that is used to carry out the methods of claims 1 and 23-25.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

11. **Claims 1-3 and 5 and 8 and 12 and 22-23 and 25 are rejected under 35 U.S.C. 102(a)**
as being anticipated by King et al. (USPN 5,956,737—filing date 9/9/1996),
hereinafter King
12. **Regarding independent claim 1**, King, in col. 3, lines 31-51, describes a method of organizing a plurality of images in a predetermined page format (King describes a method of finding a layout for a composition, which may consist of images only), grouping said plurality of images into a plurality of different page layouts (King uses a media tree of different layouts to arrive at the eventual layout), analyzing each of said different page layouts in accordance with a predetermined criteria (in col. 3, lines 19-21, King's tree analysis proceeds until primitives are reached), and selecting the page layout based on said predetermined criteria because that is an inherent part of processing the images according to the media tree King uses.
13. **Regarding dependent claim 2**, King in col. 49, lines 48-58, describes the process by which media content is fit to the calculated layout. This constitutes a method further comprising placing said plurality of images in said selected page layout.
14. **Regarding dependent claim 3**, King cites a white space scale factor, which necessarily implies that said predetermined criteria comprises the amount of white space in each of said page layouts.
15. **Regarding dependent claim 5**, King describes in col. 41, lines 1-2 how scale factors may apply to particular design components, necessarily implying a method further comprising the step of further scaling the images of selected page layout by different amounts

16. **Regarding dependent claim 8**, King describes in the Abstract that there are “scale factors” which inherently involves a method wherein said placing of said plurality of images in said different page layouts comprises scaling all of said images such that they fit within said page format.
17. **Regarding dependent claim 12**, in col. 30, lines 65-66, King refers to taking account of a type of balance in how the elements are arranged on the page. This constitutes a method further comprising the step of spatially balancing the spacing between said images.
18. **Regarding independent claim 16**, it is a system that performs the method of claim 1 and is rejected under similar rationale.
19. **Regarding independent claim 22**, it is a computer software product encoded in a software readable medium that performs the method of claim 1 and is rejected under similar rationale.
20. **Regarding independent claim 23**, it is a claim that is identical to claim 1, except that it has the additional step of selecting a number of said images for placement on said predetermined format, but this is inherently part of the preparation for using King’s invention, which has already been used to reject claim 1, and hence claim 23 may be rejected in a similar manner.
21. **Regarding independent claim 25**, King, in col. 3, lines 31-51, describes a method of organizing a plurality of images in a predetermined page format (King describes a method of finding a layout for a composition, which may consist of images only), grouping said plurality of images into a plurality of different page layouts (King uses a

media tree of different layouts to arrive at the eventual layout), analyzing each of said different page layouts in accordance with a predetermined criteria (in col. 3, lines 19-21, King's tree analysis proceeds until primitives are reached), and selecting the page layout based on said predetermined criteria because that is an inherent part of processing the images according to the media tree King uses. King further describes an option of choosing a tentative layout in col. 43, lines 50-65, which implies selecting at least one image to be placed in a predetermined image location and inherently involves identifying said at least one image and the location of said at least one predetermined image location.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 22. Claims 4 and 9-10 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over King, further in view of Ross et al. (USPN 6,026,417—filing date 5/2/1997), hereinafter Ross**
- 23. Regarding dependent claim 4,** King fails to disclose a method wherein analyzing said different page layouts comprises scoring each of said different page layouts. However, Ross, in col. 28, lines 42-65, describes how a Page Manager calculates a closeness score as part of preparing page layouts in order to aid the decision process, which constitutes a situation wherein analyzing said different page layouts comprises scoring each of said

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different page layouts. It would have been obvious to one of ordinary skill in the art at the time of the invention to use Ross's scoring to aid the decision process of King's invention.

24. **Regarding dependent claim 9**, King discloses in the Abstract the use of a recursive design tree to compare various layouts. Since recursion is internally represented by iteration, this process necessarily involves analyzing of said different page layouts that comprises a iteration of different page layouts and selecting the best page layout until the criteria are best met. However, King fails to disclose a situation where little or no further improvement in scoring is obtained, because King's process does not involve scoring. However, Ross teaches scoring, as described above. It would have been obvious to one of ordinary skill in the art at the time of the invention to add Ross's scoring to King's recursive decision process (whose underlying nature is iterative) in order to aid in the decision process.

25. **Regarding dependent claim 10**, King states in col. 40, lines 52-54, that scale factors may be used to adjust components' fit in the layout process, which constitutes a method further comprising the step of scaling individual images of the page layout obtained after said iteration.

26. **Regarding independent claim 24**, King discloses grouping said plurality of images into a plurality of different page layouts (King uses a media tree of different layouts to arrive at the eventual layout), analyzing each of said different page layouts in accordance with a predetermined criteria (in col. 3, lines 19-21, King's tree analysis proceeds until primitives are reached), and selecting the page layout based on said predetermined

criteria because that is an inherent part of processing the images according to the media tree King uses. King fails to disclose a method a method of organizing a plurality of images in a predetermined page format including an image void area comprising the steps of: identifying an area to be void of images and including the area void of images in the plurality of page layouts. However, Ross discloses in col. 10, lines 45-47, that objects may be empty in order to allow for proper positioning of document contents. It would have been obvious to one of ordinary skill in the art at the time of the invention to use Ross's empty objects in order to allow for proper positioning of document contents, which would necessarily imply a method of organizing a plurality of images in a predetermined page format including an image void area comprising the steps of: identifying an area to be void of images and including the area void of images in the plurality of page layouts.

27. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over King, further in view of Nakatake et al., from the applicant's previously disclosed prior art, hereinafter Nakatake

28. Regarding dependent claim 6, King fails to disclose a method wherein the amount of white space is minimized by using stochastic algorithms. However, Nakatake's teachings are relevant to an analogous situation, in which chips are arranged on an integrated circuit. In this situation, on pages 487-488 of the paper, Nakatake refers to using simulated annealing, which is a type of stochastic algorithm, because it packs with good area efficiency and therefore minimizes white space. It would have been obvious to one of ordinary skill in the art at the time of the invention to use Nakatake's method of

simulated annealing to pack with good area efficiency, thereby resulting in a method wherein the amount of white space is minimized by using stochastic algorithms.

29. Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over King, further in view of Fukui et al. (USPN 5,742,837—filing date 8/26/1994), hereinafter Fukui

30. Regarding dependent claim 7, King fails to disclose a method wherein said predetermined criteria include placing images in said different page layouts in a non-overlapping pattern. However, Fukui, in col. 7, lines 59-60, lists lack of overlapping as a criterion because it allows for an aesthetically pleasing layout. It would have been obvious to one of ordinary skill in the art at the time of the invention to use Fukui's criterion of avoiding overlap in order to arrive at a more aesthetically pleasing layout, thereby resulting in a method wherein said predetermined criteria include placing images in said different page layouts in a non-overlapping pattern.

31. Claims 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over King, further in view of Ross, further in view of Bottomly (USPN 5,900,002—filing date 1/9/1995)

32. Regarding dependent claim 11, King and Ross fail to disclose a method further comprising the step of rotating said images a predetermined amount. However, Bottomly, in col. 4, lines 21-31, discloses a process by which regions of the page are rotated 180 degrees to aid in orienting. It would have been obvious to one of ordinary skill in the art at the time of the invention to use Bottomly's method of rotating 180

degrees to aid in orienting, and this would have constituted a method further comprising the step of rotating said images a predetermined amount.

33. Claims 13 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over King, further in view of Burns (USPN 6,014,137—filing date 2/27/1997)

34. Regarding dependent claim 13, King fails to disclose a method further comprising the step of positioning said images in said selected page layout so as to provide a desired border on said page. However, Burns in col. 3, line 59 refers to the use of window borders in a kiosk authoring system that would require image arrangement in order to present the user with an aesthetically pleasing layout. It would have been obvious to one of ordinary skill in the art at the time of the invention to use borders in the method that Burns teaches in order to present the user with an aesthetically pleasing layout. Such a method would constitute a method further comprising the step of positioning said images in said selected page layout so as to provide a desired border on said page.

35. Regarding dependent claim 21, King fails to disclose a system wherein said computer is access by a retail kiosk. However, Burns, in col. 1, lines 11-37 reveals that kiosks are a popular method of providing information because they are generally accessible to the public. It would have been obvious to one of ordinary skill in the art at the time of the invention to have said computer be accessed by a retail kiosk in the manner of Burns, because then it would be generally accessible to the public.

36. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over King, further in view of Burns, further in view of Archibald (USPN 5,459,826—filing date 5/25/1990)

37. **Regarding dependent claim 14**, King and Burns fail to disclose a method according to claim 12 wherein said white space is determined vertically between adjacent images in said page layouts. However, Archibald, in col. 3, lines 12-19, discloses the use of a vertical-horizontal grid pattern to organize the components for the layout efficiently, and this constitutes determining the white space vertically (as well as horizontally). It would have been obvious to one of ordinary skill in the art at the time of the invention to follow Archibald's teachings and have said white space be determined vertically between adjacent images in said page layouts in order to organize the components for the layout efficiently.

38. **Regarding dependent claim 15**, King and Burns fail to disclose a method according to claim 12 wherein said white space is determined horizontally between adjacent images in said page layouts. However, Archibald, in col. 3, lines 12-19, discloses the use of a vertical-horizontal grid pattern to organize the components for the layout efficiently, and this constitutes determining the white space horizontally (as well as vertically). It would have been obvious to one of ordinary skill in the art at the time of the invention to follow Archibald's teachings and have said white space be determined horizontally between adjacent images in said page layouts in order to organize the components for the layout efficiently.

39. **Claims 17-20 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over King**

40. **Regarding dependent claim 17**, King fails to disclose a system wherein said computer can be accessed remotely over a communication network. However, it was notoriously

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well known in the art at the time of the invention that computers may be accessed remotely over communications networks to provide access to their resources when their users are at a remote location. It would have been obvious to one of ordinary skill in the art at the time of the invention to build a system wherein said computer can be accessed remotely over a communication network in order to provide access to their resources when their users are at a remote location.

41. **Regarding dependent claim 18**, King fails to disclose a system wherein said computer is accessed by a second computer. However, it was notoriously well known in the art at the time of the invention that in a network, computers are accessed by other computers in the network in order to make use of their capabilities. It would have been obvious to one of ordinary skill in the art at the time of the invention to build a system wherein said computers is accessed by a second computer so that the second computer could make use of the first computer's capabilities.

42. **Regarding dependent claim 19**, King fails to disclose a system wherein said software program is run on said first computer. However, it was notoriously well known in the art at the time of the invention that in an invention where a piece of software is designed for a function, it should be run on appropriate hardware in order to be functional. It would have been obvious to one of ordinary skill in the art at the time of the invention to build a system wherein said software program is run on said first computer so that the software may be functional.

43. **Regarding dependent claim 20**, King fails to disclose a system wherein the second computer is the personal computer of a customer. However, it was notoriously well

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known in the art at the time of the invention that customers often use their personal computers to access photo services because this is a convenient means of access for him or her. It would have been obvious to one of ordinary skill in the art at the time of the invention to build a system wherein the second computer is the personal computer of a customer because this is a convenient means of access for him or her.

44. **Regarding dependent claim 26**, King fails to disclose a computer software product further causing a computer that runs it to perform the additional step of permitting a user to request another page layout. However, it was notoriously well known in the art at the time of the invention that computer software products that perform a task often allow the user the option of performing the task again for the user's convenience. It would have been obvious to one of ordinary skill in the art at the time of the invention to allow the user to perform the page layout again for the user's convenience.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USPN 5,293,475 (filing date 11/18/1991)—Hennigan et al.

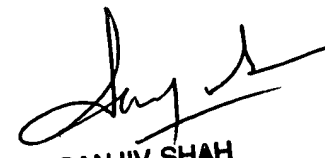
USPN 5,517,621 (filing date 12/7/1990)—Fukui et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan D. Schlaifer whose telephone number is 703-305-9777. The examiner can normally be reached on 8:30-5:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

JS



SANJIV SHAH
PRIMARY EXAMINER